

Application No. 09/613,085
Amendment Dated March 12, 2004
Reply to Office Action of November 12, 2003

REMARKS/ARGUMENTS

Claims 1-3, 5-7, and 9-11 have been amended. No new claims have been added. No claims have been canceled. Claims 1-12 remain pending in this application. Reexamination and reconsideration of the application as amended are respectfully requested.

Information Disclosure Statement

The Information Disclosure Statement filed 2-2-2001 has been considered by the Examiner. Applicant notes that this Information Disclosure Statement contains copies of the same references that the Examiner alleged were missing from related application serial number 10/613,083, IBM docket number STL9-2000-0055.

Informality Objections to Claims 3, 7, and 11

The Examiner objected to claims 3, 7, and 11 because of the following informalities: "translation applies the subsequent portion of the computer program" fails to point out what the translation applies to. The Examiner required appropriate correction. Applicant has amended claims 3, 7, and 11 making appropriate corrections so that it now reads: "translation applies ~~the~~ to a subsequent portion of the computer program". Applicant therefore respectfully requests that the Examiner reconsider and withdraw the objections to claims 3, 7, and 11.

Application No. 09/613,085
Amendment Dated March 12, 2004
Reply to Office Action of November 12, 2003

Rejections under 35 U.S.C. § 103 of Claims 1-12

The Examiner rejected claims 1-12 under 35 U.S.C. § 103(a) as being unpatentable over *Edberg et al.*, U.S. Patent No. 5,793,381. Applicant respectfully traverses this rejection for the reasons set forth below.

Independent claims 1, 5, and 9 have been amended. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the 35 U.S.C. § 103(a) rejections of claims 1, 5, and 9.

Relative to dependent claims 2-4, 6-8, and 10-12, these dependent claims depend from independent claims 1, 5, and 9, respectively. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Since these dependent claims depend from independent claims 1, 5, and 9, and Applicant believes he has successfully traversed the Examiner's rejection of independent claims 1, 5, and 9, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections of dependent claims 2-4, 6-8, and 10-12.

The Examiner rejected independent claims 1, 5, and 9 under 35 U.S.C. § 103(a) as being unpatentable over *Edberg et al.*. The Examiner's rejection of independent claims 1, 5, and 9 under 35 U.S.C. § 103(a) is reproduced here in its entirety from as follows:

Application No. 09/613,085

Amendment Dated March 12, 2004

Reply to Office Action of November 12, 2003

“Regarding independent claim 1, Edberg teaches a code converter stored in a computer readable medium for converting non-Unicode strings to Unicode looking up a mapping table -- *retrieving a specification code page* -- containing the Unicode or “second character encoding”, and the non-Unicode string encoding for converting to Unicode (col. 3, lines 42-61, col. 4, lines 10-67, and col. 11, line 47-col.12, line 67).

Furthermore, Edberg teaches a code converter stored in a computer readable medium for converting non-Unicode strings -- *a scope* -- to Unicode (col. 3, lines 42-61, and col. 4, lines 10-67). Edberg fails to explicitly disclose: *specifying a portion of a computer program subject to the translation*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have converted the portion of the computer program, because this would provide the benefit of allowing people of different nationalities to interact with the computer in a different language as taught by Edberg (col. 1, lines 36-41). Thereby providing a user in a different language with the ability to interact with a program -- strings -- in another language.” (Second and third paragraphs of Section 7 of the Office Action dated November 12, 2003.)

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Application No. 09/613,085
Amendment Dated March 12, 2004
Reply to Office Action of November 12, 2003

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.” *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” MPEP 2143, Basic Requirements of a *Prima Facie* Case of Obviousness.

The Examiner’s rejection of independent claims 1, 5, and 9 under 35 U.S.C. § 103(a) fails to establish a *prima facie* case of obviousness. Relative to the first criteria that there must be some suggestion or motivation to modify the reference or to combine reference teachings found in the prior art, not in applicant's disclosure, the Examiner asserts a suggestion or motivation to modify the reference *Edberg et al.* which is found in the Applicant's disclosure. The suggestion or motivation to modify the reference alleged by the Examiner would provide the benefit of allowing people of different nationalities to interact with the computer in a different language. However, Applicant’s disclosure reads:

“As will be appreciated upon reference to the foregoing, it may be desirable for a user to develop a multi-lingual or multi-alphabet software application. For example, a user of a software supplier in England may develop an account management program on a workstation **12** for use on a French company’s computer **26** wherein the French company has a subsidiary in Belgium running a computer **28** which must process requests from users operating computers **30**, each of which may be interfacing in a different language,

Application No. 09/613,085

Amendment Dated March 12, 2004

Reply to Office Action of November 12, 2003

such as Danish, Dutch, French, Flemish, or German. The present invention provides character specification and conversion capabilities to accommodate such a variety of alphabets and characters.” (p. 15, lines 12-19, Applicant’s Disclosure)

Thus, the Examiner’s rejection of independent claims 1, 5, and 9 fails to establish a *prima facie* case of obviousness as it does not establish a suggestion or motivation to modify the reference or to combine reference teachings not found in Applicant’s disclosure. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the 35 U.S.C. § 103(a) rejections of independent claims 1, 5, and 9.

Relative to dependent claims 2-4, 6-8, and 10-12, these dependent claims depend from independent claims 1, 5, and 9, respectively. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Since these dependent claims depend from independent claims 1, 5, and 9, and Applicant believes he has successfully traversed the Examiner’s rejection of independent claims 1, 5, and 9, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections of dependent claims 2-4, 6-8, and 10-12.

Prior Art Made of Record and Not Relied Upon

Applicant has reviewed the prior art made of record and not relied upon considered pertinent to Applicant’s disclosure, and these fail to teach or suggest the claimed invention.

Application No. 09/613,085

Amendment Dated March 12, 2004

Reply to Office Action of November 12, 2003

Conclusion

Applicant therefore respectfully requests that the Examiner reconsider all currently outstanding objections and rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this Application, the Examiner is invited to telephone the undersigned at the number provided. Prompt and favorable consideration of this Response is hereby solicited.

Respectfully submitted,
John R. Ehrman

By: 

Prentiss Wayne Johnson, Reg. No. 33,123
Attorney for Applicant
International Business Machines Corporation
Intellectual Property Law
555 Bailey Avenue, J46A/G467
San Jose, CA 95141-9989
Telephone: 408.463.5673

Date: March 12, 2004